Election/Restrictions and Objection to Claims 36-37

Claim Objections

1. Claims 36-37 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 21, drawn to a "generating device" (for defining races in a worm 2).

Group II, claim(s) 3, 22, and 23, drawn to a "cutting tool-gear" (used, as disclosed, for cutting races of the worm wheel 3).

Group III, claim(s) 6 and 24-35, drawn to a "method for cutting a worm and a worm wheel".

3. As a side note, claims 36-37 would require amendment before being treated on the merits (see the above objection to those claims). That said, it would depend on how these claims were amended as to which group they go with.

4. Firstly, comparing Group I (directed to a "generating device") to Group III (a "method for cutting a worm and a worm wheel"):

The invention listed as Group I as compared to Group III does not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I lacks unity of invention with Group III *a priori*, noting the lack of any same or corresponding features between Groups I and III, as evidenced by a comparison of independent claims 1 (of Group I) and 6 (of Group III), noting that claim 6 does not require a generating device at all, much less one structured as set forth in independent claim 1.

5. Secondly, comparing Group II (directed to a "cutting tool-gear") to Group III (a "method for cutting a worm and a worm wheel"):

The invention listed as Group II as compared to Group III does not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group II lacks unity of invention with Group III *a priori*, noting the lack of any same or corresponding features between Groups II and III, as evidenced by a comparison of independent claims 3 (of Group II) and 6 (of Group III), noting that claim 6 does not require a "cutting tool-gear" at all (as opposed to, for example, an end mill), much less one structured as set forth in independent claim 3.

6. Secondly, comparing Group I (directed to a "generating device") to Group II (a "cutting tool-gear"):

The invention listed as Group I as compared to Group II does not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Firstly, it is noted that claim 3 does not appear to include all of the limitations of claim 1, but merely appears to includes a shape or envelope that is recited in claim 1. In other words, claim 3 does not recite the combination of the generating device 5 and the cutting tool gear 7, but merely recites a cutting tool gear having a shape or envelope like that of the generating device 5 of claim 1.

That said, it appears that Group I lacks unity of invention with Group II *a priori*, noting the lack of any same or corresponding features between Groups I and II, as evidenced by a comparison of independent claims 3 (of Group II) and 1 (of Group I), noting that claim 3 does not require a "generating device" at all (as opposed to, for example, the shape of a generating device).

In the alternative, in the event that the shape of the generating device 5 of claim 1 is considered to constitute same or corresponding features between claims 1 and 3 (and thus Groups I and II), then in accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of at least WO 03/042574, for example. Specifically, it is noted that, in such a case, the features which are common to claims 1 and 3 are considered to be as follows: a shape defined as the shape of the generating device as set forth in claim 1. Note that such a shape is taught by WO 03/042574, as set forth in detail in the International Preliminary Report on Patentability (Form PCT/ISA/237) (on page 4 thereof) for PCT/IB2005/050898, which is the PCT of which the present application is that national stage.

7. Though there is no separate burden requirement for establishing a lack of unity of invention, in the interest of being thorough, Examiner notes that restriction for examination purposes as indicated is proper because a lack of unity exists between all these inventions for the reasons given above and there would be a serious search and examination burden if restriction were not required at least because the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries), the prior art applicable to one invention would not likely be applicable to another invention, and/or the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

8. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants

or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on Monday-Thursday, 5:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erica E Cadugan/
Primary Examiner
Art Unit 3726

eec
April 21, 2010